REMARKS

Summary of the Amendment

Upon entry and consideration of the instant amendment, claims 224, 228, 229, 256, 257 and 274 will have been amended. Accordingly, claims 224-243 and 245-289 will be pending and under consideration.

Summary of the Official Action

In the instant Office Action, the Examiner objected to claim 228. The Examiner also rejected claims 232, 252 and 253 as being non-enabled. Finally, the Examiner rejected claims 224-243 and 245-289 over the applied art of record. By the present remarks, Applicant submits that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Interview of June 30, 2010

Applicant appreciates the courtesy extended by Examiner Fortuna in the telephone Interview of June 30, 2010.

In the Interview, Applicant's representative discussed the various objections and rejections.

In response to Applicant's representative, the Examiner agreed to at least the following:

that amending claim 228 to recite additional structural features would resolve the claim objection; and

that amending claims 224 and 274 to recite a mechanism for at least one of controlling and measuring a line force in the winding nip would advance prosecution and possibly overcome the

applied art.

The Examiner, however, indicated that such an amendment would require further search and consideration before he could indicate allowance.

The Claim Objection is Moot and/or Improper

The Examiner objects to claim 228 on the basis of Rule 1.75(c) as being in improper dependent form and not further limiting the claim from which it depends. While Applicant respectfully disagrees, Applicant has herein amended claim 228 to recite a structural feature which additionally further limits the claim from which it depends in an effort to advance prosecution.

Accordingly, Applicant requests that the Examiner reconsider and withdraw the objection to the specification.

The Section 112, 1ST Paragraph, Rejection is Improper

Claims 232, 252 and 253 were rejected as allegedly being non-enabled. Applicant respectfully disagrees and submits that to the extent that the Examiner believes that the claims are non-enabled for omitting features (which appears to be what the Examiner is arguing) along the lines of MPEP 2172.01, Applicant submits that they are not required under section 112, either first or second paragraphs, to limit the invention to any particular cooperative relationship between the recited structural features.

Applicant respectfully submits the Examiner has misunderstood the enablement requirement and notes that no MPEP section is cited in support of the Examiner's rejection. It is noted that MPEP 2172.01, which speaks to omitted claim features, is not cited by the Examiner.

Applicant is unaware of any requirement, under either the patent statutes or rules, requiring Applicant to limit the invention to any particular or preferred disclosed embodiment. Applicant submits that if the claim limitations are clear and have support in the specification, they cannot be properly rejected as non-enabled, or as indefinite as the Examiner has alleged in the previous Office Action, merely because the Examiner would prefer that the claims recite more detailed limitations.

Applicant emphasizes that, other than alleging non-enablement, the Examiner has set forth no legal basis for requiring Applicant to limit the invention in the suggested manner. Section 112, 1st paragraph, does not require Applicant to specify the relationship between the hood and a drying cylinder and/or features previous recited in other claims.

Finally, Applicant directs the Examiner's attention to page 5 of the attached non-precedential decision in *Ex parte COK*, which explains that a mere allegation or conclusion by the Examiner that the specification does not enable the claimed invention and without demonstrating the required undue experimentation is insufficient to satisfy the Examiner's initial burden of demonstrating non-compliance with the enablement requirement.

Accordingly, Applicant respectfully submits that the rejection of the above-noted claims should be withdrawn.

Traversal of Rejection Under 35 U.S.C. § 102/103

Applicant traverses the rejection of claims 224-237, 240, 241, 243, 255, 256, 259, 260, 264, 269 and 274-289 under 35 U.S.C. § 102(e) as being anticipated by US Patent Application Publication No. 2003/0111199 to CLARKE et al.

In the rejection, the Examiner asserted that CLARKE discloses or suggests all the recited

features of these claims, including the recited free web draw. Applicant respectfully traverses this rejection.

Applicant respectfully submits that this rejection is improper because CLARKE fails to disclose, or even suggest: inter alia, at least one drying cylinder, a creping doctor arranged on the at least one drying cylinder, a winding device for winding up the tissue web, the winding device comprising a winding nip formed between a winding drum and a spool, a transfer device at least largely bridging an entire distance between the creping doctor and the winding device and moves around the winding drum of the winding device, a free web draw arranged between the creping doctor and the winding device, and a mechanism for at least one of controlling and measuring a line force in the winding nip, wherein the tissue web is supported on only one side by the transfer device between the free web draw and the winding nip, and wherein the line force is less than or equal to 0.8 kN/m, as recited in amended independent claim 224; and inter alia, at least one drying cylinder, a creping doctor arranged on the at least one drying cylinder, a winding device for winding up the tissue web, the winding device comprising a winding nip formed between a winding drum and a spool, a transfer belt at least largely bridging an entire distance between the creping doctor and the winding device and moving around the winding drum of the winding device; a free web draw arranged between the creping doctor and the winding device, and a mechanism for at least one of controlling and measuring a line force in the winding nip, wherein the tissue web is supported on only one side by the transfer belt between the free web draw and the winding nip and the tissue web has an opposite unsupported side between the creping doctor and the winding device, and wherein the line force is less than or equal to 0.8 kN/m, as recited in amended independent claim 274.

Applicant does not dispute that CLARKE teaches a paper machine utilizing a free web draw between a doctor and a transfer belt (see, e.g., Fig. 4). Applicant also acknowledges that Fig. 4 of CLARKE shows a winding nip between reel drum 36a and spool 37a (see paragraph [0036]). However, it is submitted that CLARKE does not teach or suggest a mechanism for at least one of controlling and measuring a line force in the winding nip, much less, that the line force is less than or equal to 0.8 kN/m. Indeed, the Examiner has acknowledged as much on top of page 5 of the instant Office Action.

Furthermore, although the Examiner has alleged that CLARKE is inherently capable of producing the recited line force, no prior art basis is cited in support of this assertion. Moreover, even if this were correct (which Applicant would dispute), it would not address the fact that CLARKE fails to teach or suggest a mechanism for at least one of controlling and measuring a line force in the winding nip. Indeed, the language of CLARKE discussing the winding/reeling of the web on paragraph [0036] is entirely silent regarding the winding nip pressure or line force and/or any mechanisms for controlling or measuring the same. Indeed, the Examiner has acknowledged as much in the telephone Interview of June 30, 2010.

For the foregoing reasons and because this document fails to disclose the above-noted features of the instant invention, Applicant submits that this document fails to disclose each and every recited feature of claims 224 and 274. Accordingly, Applicant submits that the Examiner has failed to provide an adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. § 102(e) and/or obviousness under 35 U.S.C. § 103(a), and that the instant rejection is improper.

Finally, Applicant submits that dependent claims 225-237, 240, 241, 243, 255, 256, 259, 260, 264, 269 and 275-289 are allowable at least for the reason that these claims depend from an

allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that CLARKE cannot be read to disclose or suggest each of the additional features recited in these claims.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Traversal of Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 238, 239, 242, 245-254, 257, 258, 261-263, 265-268 and 270-273 under 35 U.S.C. § 103(a) as unpatentable over CLARKE alone.

The Examiner acknowledges that CLARKE lacks, among other things, the recited features of these claims. However, the Examiner asserts that such features are well known and that it would have been obvious to one of ordinary skill in the art to modify CLARKE so as to utilize such known devices. Applicant respectfully traverses this rejection.

Notwithstanding the Office Action assertions as to what this document discloses or suggests, Applicant submits that no proper modification of this document discloses or suggests: inter alia, at least one drying cylinder, a creping doctor arranged on the at least one drying cylinder, a winding device for winding up the tissue web, the winding device comprising a winding nip formed between a winding drum and a spool, a transfer device at least largely bridging an entire distance between the creping doctor and the winding device and moves around the winding drum of the winding device, a free web draw arranged between the creping doctor and the winding device, and a mechanism for at least one of controlling and measuring a line force in the winding nip, wherein the tissue web is supported on only one side by the transfer device between the free web draw and the winding nip, and wherein the line force is less than or equal to 0.8 kN/m, as recited in amended independent claim

224.

As explained above, Applicant does not dispute that CLARKE teaches a paper machine utilizing a free web draw between a doctor and a transfer belt (see, e.g., Fig. 4). Applicant also acknowledges that Fig. 4 of CLARKE shows a winding nip between reel drum 36a and spool 37a (see paragraph [0036]). However, it is submitted that CLARKE does not teach or suggest a mechanism for at least one of controlling and measuring a line force in the winding nip, much less, that the line force is less than or equal to 0.8 kN/m. Indeed, the Examiner has acknowledged as much on top of page 5 of the instant Office Action. Furthermore, even if the Examiner were correct that CLARKE is inherently capable of producing the recited line force (which Applicant would dispute), no prior art basis is cited in support of this assertion. Moreover, it would not address the fact that CLARKE fails to teach or suggest a mechanism for at least one of controlling and measuring a line force in the winding nip. As noted above, the language of CLARKE discussing the winding/reeling of the web on paragraph [0036] is entirely silent regarding the winding nip pressure or line force and/or any mechanisms for controlling or measuring the same. Indeed, it is noted again that the Examiner has acknowledged as much in the telephone Interview of June 30, 2010.

Thus, Applicant submits that the above-noted document fails to disclose or suggest the features recited in at least independent claim 224. Because no proper modification of the above-noted document discloses or suggests at least the above-noted features of the instant invention, Applicant submits that no proper modification of this document can render unpatentable the combination of features recited in at least independent claim 224.

Furthermore, Applicant submits that there is no rationale disclosed or suggested in the art to modify any of the applied document in the manner asserted by the Examiner. The allegedly well known features do not cure the above-noted deficiencies. Therefore, Applicant submits that the

invention as recited in at least independent claim 224 is not rendered obvious by any reasonable inspection of this disclosure.

Finally, Applicant submits that dependent claims 238, 239, 242, 245-254, 257, 258, 261-263, 265-268 and 270-273 are allowable at least for the reason that these claims depend from an allowable base claim and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper modification of CLARKE discloses or suggests; the specific additional features recited in the above-noted dependent claims.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection and further requests that the above noted claims be indicated as allowable.

Application is Allowable

Thus, Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§ 112, 102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim.

Authorization to Charge Deposit Account

The Commissioner is authorized to charge to Deposit Account No. 19-0089 any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, in order to maintain pendency of this application.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention, as

recited in each of the pending claims. The applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
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Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD S. COK and JOHN R. FREDLUND

Appeal No. 1998-2707
Application No. 08/586,081

ON BRIEF

Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to a system for producing composite images which provides a measure of security to vendors and consumers. Representative claim 1 is reproduced below.

1. A system for producing composite images, comprising:

a) a digital image file containing a personal image and image control data related to the personal image;

b) a digital image file containing an image template and image template control data related to the image template;

c) a file containing composite image construction rules and composite control data related to the image construction rules; and

d) an image production system including,

i) a file containing production rule data including data indicating whether production is enabled or disabled;

ii) a control module for: receiving a customer order including customer order control data; retrieving the image control data, the image template control data, the composite control data and the production rule data; and generating an ENABLE/DISABLE control signal by comparing the production rule data with the image control data, the image template control data and the composite control data to generate the ENABLE/DISABLE control signal; and

iii) a composite image production module responsive to the ENABLE/DISABLE control signal for employing the personal image, the image template, and the composite image construction rules to produce the composite image.

The examiner relies on the following reference:

Krahe et al. (Krahe)	5,608,542	Mar. 4, 1997 (filed Mar. 31, 1995)

Claims 1-16 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement.

Claims 1, 5, 9, and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by Krahe.

Claims 2-4, 6, 8, 10-12, 14, and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Krahe in view of "well known prior art."

We refer to the Final Rejection (mailed Oct. 28, 1997) and the Examiner's Answer (mailed June 8, 1998) for a statement of the examiner's position and to the Brief[1] (filed June 10, 1998; certificate of mailing June 5, 1998) for appellants' position with respect to the claims which stand rejected.

OPINION

Before turning to the instant rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph, we briefly review the requirements of the statute with respect to providing an enabling disclosure.

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[1] Appellants filed an earlier brief on April 24, 1998. The brief to which we refer in this decision is that filed June 10, 1998, submitted as an "amended" brief, which removes reference to an amendment filed subsequent to the Final Rejection that was refused entry by the examiner.

> The first paragraph of 35 U.S.C. 112 requires, inter alia, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without 'undue experimentation.' In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is 'undue.' Id. at 736-37, 8 USPQ2d at 1404.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987). "Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed

enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The statement of the rejection (Answer at 5-6) does little to meet the initial burden. The rejection merely alleges that the specification does not enable an aspect of the claimed invention. A mere allegation cannot demonstrate lack of enablement. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

> (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

The statement of the rejection is thus plainly deficient.[2] Moreover, the Answer's "Response to Arguments" section indicates that the examiner's standard for enablement was based on an improper legal footing. "Surely there are other circuits, templates or other mechanisms, which applicant has [sic; applicants have] not disclosed, to make the

[2] We note that Office policy is to consider all the relevant factors when making a rejection for lack of enablement. "The examiner's analysis must consider all the evidence related to each of these [Wands] factors, and any conclusion of nonenablement must be based on the evidence as a whole." Manual of Patent Examining Procedure § 2164.01(a), Seventh Edition, Rev. 1 (Feb. 2000).

present invention. But rather, appellant has [sic; appellants have] relied on what one of ordinary skill in the art would have known regarding the comparison." (Answer at 17.) The Answer further indicates, in the paragraph bridging pages 17 and 18, that extrinsic evidence in support of enablement will not be considered, because "such information is not part of the original disclosure and could not be entered now for reason of new matter and new issues after final rejection."

However, an applicant need not, and preferably does not, disclose what is already well known in the art. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." U.S. v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (emphasis added) (citing Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986)). Determining what the specification fails to explicitly set forth is, at best, only a first step in demonstrating that a disclosure is not enabling. As the precedents of our reviewing court make plain, determining whether "undue experimentation" is required involves weighing factors beyond what the specification explicitly sets forth.

For example, with respect to the seventh Wands factor -- the predictability or unpredictability of the art -- the level of predictability in the mechanical and electrical arts is recognized as being relatively high. See, e.g., In re Hogan, 559 F.2d 595, 606, 194 USPQ 527, 537-38 (CCPA 1977) (taking notice of the high level of predictability in mechanical or

electrical environments and the lower level of predictability expected in chemical reactions and physiological activity).

Upon weighing the factual considerations before us, we do not agree that the instant disclosure fails to teach the artisan how to make and use the claimed invention. At least for the reason that the rejection fails to consider the evidence as a whole, we do not sustain the rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph.[3]

Turning to the section 102 rejection of claims 1, 5, 9, and 13 as being anticipated by Krahe, we agree with appellants that the reference fails to meet all limitations of each of independent claims 1 and 9. In particular, the rejection (Answer at 7-10) refers to "production rule data," but does not show that Krahe discloses "production rule data including data indicating whether production is enabled or disabled," and "generating an ENABLE/DISABLE control signal by comparing the production rule data with the image control data, the image template data and the composite control data to generate the ENABLE/DISABLE control signal," as required by each of independent claims 1 and 9.

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[3] We are, however, somewhat puzzled by statements in the 37 CFR § 1.132 declaration submitted by appellants' expert on April 24, 1998 in support of enablement. Appellants' expert alleges (¶ 8), with respect to certain production rules set forth in the specification, "the control data for such production rules is not described sufficiently completely in the specification for me to render an opinion as to whether a program could have been written to implement these particular production rules...." The statement at least raises the question whether the full scope of the claims has been enabled. However, in predictable arts, a single embodiment may provide broad enablement. See In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Here, there are ten production rules (specification at 8-10) that appellants assert to be enabled, even though four, perhaps, are not. In any event, the examiner's rejection is not based on the question of whether the claims bear a "reasonable correlation" to the scope of enablement provided by the specification, nor does the examiner rely on the averment regarding what "is not described sufficiently completely."

The deficiency in the section 102 rejection may be related to the indication on page 6 of the Answer that the relevant limitations are given "no weight" due to the alleged lack of enablement. If that is the case, the section 102 rejection is flawed at the outset. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

We therefore do not sustain the section 102 rejection, nor the section 103 rejection of claims 2-4, 6, 8, 10-12, 14 and 16. The section 103 rejection does not deal with all the requirements of independent claims 1 and 9, and fails at least on that basis. We note that, at page 19 of the Answer, the examiner appears to submit appellants' arguments for enablement as evidence of obviousness of the claimed subject matter. However, the enablement issue is related to implementation of the details of the invention, rather than what the prior art would have suggested to the artisan. Cf. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 941, 15 USPQ2d 1321, 1329 (Fed. Cir 1990) ("The claimed invention...is not in the details of the program writing, but in the apparatus and method whose patentability is based on the claimed combination of components or steps.")

CONCLUSION

The rejection of claims 1-16 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
ANITA PELLMAN GROSS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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